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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/126,096	07/30/1998	EUGENE D. THORSETT	002010-137	8518

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EXAMINER	
RAO, DEEPAK R	

ART UNIT	PAPER NUMBER
1624	24

DATE MAILED: 03/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/126,096	Applicant(s) Thorsett et al.
	Examiner Deepak Rao	Art Unit 1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jan 24, 2002* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-4, 7, 10, 12, 13, and 15-22* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-4, 7, 10, 12, 13, and 15-22* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *19 & 20*

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

This office action is in response to the amendment filed on January 24, 2002. The amendment has been entered. Claims 1-4, 7, 10, 12-13 and 15-22 are currently pending in this application.

Upon reconsideration, the finality of that action is withdrawn and the following rejections are made under new grounds:

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 7, 10, 12-13 and 15-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1. In claim 1, in the definition of heterocyclic group, the term "contains" (line 10) is open ended. 'Contains' in a compound claim, leaves the claim open for the inclusion of unspecified groups and/or substituents. The use of the above phrase causes the claim to be broader than the invention. See *In re Fenton*, 451 F.2d 640, 171 USPQ 693 (CCPA 1971). Replacing with -- consists of -- respectively is suggested. The same discrepancy appears in claims 2 and 16.

2. Claim 12 recites the limitation "4-imidazolyl" in page 131, line 28. There is insufficient antecedent basis for this limitation in claims 1 or 2 on which claim 12 is dependent. Claim 12 recites various groups that fall within the definition of R^5, however, claims 1 and 2 define R^5 to be isopropyl, $-CH_2-X$ or =CH-X and the instant definition of '4-imidazolyl' does not fit within the definitions provided for R^5 in claims 1 or 2.

3. In claim 12, the term "methyl" is repeated under the definition of R^5, see page 131, line 17 and page 132, line 21.

4. In claim 22, the first following the species, the recitation "**as well as** any of the ester..." is confusing and improper. Replacing the term "as well as" with -- or -- will obviate this rejection.

Claims not particularly addressed above are included here because they are dependent claims and do not further resolve the above issues.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 3, 4, 7, 10, 15-18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Durette et al., U.S. Patent No. 6,291,511 (effective filing date: May 29, 1997). The instantly claimed compounds read on the compounds of the reference, see the structural formula I in col. 4 and the more preferred formula Ia in col. 8 and the various examples having L-prolyl groups. The reference teaches that the compounds are useful as pharmaceutical therapeutic agents for the treatment of various diseases, see col. 10, lines 41+.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 13 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durette et al., U.S. Patent No. 6,291,511. The reference teaches a generic group of compounds which embraces applicant's instantly claimed compounds. See formula I in col. 4 wherein R^2 and R^3 together with the atoms to which they are attached form a heterocyclic ring. The compounds are taught to be useful as therapeutic agents, see col. 10, lines 41+. The claims differ from the reference by reciting a specific species and/or a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole i.e., as pharmaceutical therapeutic agents. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. It has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. *In re Susi*, 440 F.2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in *Merck & Co. v. Biocraft Laboratories*, 847 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

Receipt is acknowledged of the Information Disclosure Statements filed on July 23, 2001 and October 2, 2001 and copies are enclosed herewith.

Allowable Subject Matter

Claim 22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. Claim 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The instant claims are neither anticipated nor rendered obvious by the references of record. The closest reference, Durette et al., US'511 teaches structurally analogous compounds, however, the compounds always have a -alkyl-Ar^1-Ar^2 group in a position analogous to the position of R^5 in the instantly claimed formula I or IA.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Deepak Rao
March 6, 2002